

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ZILKR CLOUD TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2023-00822
Patent 9,883,047

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST**Currently Filed – Patent Owner**

Ex. No.	Description
2001	Declaration of Robert Akl, D.Sc.
2002	Claim Construction Order, <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP, Dkt. No. 121 (E.D. Tex. Aug. 3, 2023)
2003	Second Amended Docket Control Order, <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP, Dkt. No. 146 (E.D. Tex. Aug. 30, 2023)

CLAIM LISTING

Independent Claim 1	
1.0	A method of provisioning a service for use with a group plan, the method comprising:
1.1	receiving, by a unified services platform system, a subscription request for a service for a group plan,
1.2	wherein the group plan comprises a plurality of telephone numbers, wherein each telephone number of the plurality of telephone numbers is associated with a subscriber, and
1.3	wherein the service is provided by a third party application service provider system;
1.4	sending, by the unified services platform system, an activation request for the group plan to the third party application service provider system;
1.5	receiving an activation response from the third party application service provider system;
1.6	associating the service with each telephone number of the plurality of telephone numbers;
1.7	providing access to the service for each telephone number based on the associating;
1.8	receiving, by the unified services platform system, a subscription request for a second service from a subscriber associated with a first telephone number of the plurality of telephone numbers,

1.9	wherein the second service is provided by a second third party application service provider system;
1.10	sending, by the unified services platform system, a second activation request for the service to the second third party application service provider system;
1.11	receiving a second activation response from the second third party application service provider system;
1.12	associating the second service with the first telephone number; and
1.13	providing access to the second service for the first telephone number based on the associating.

Dependent Claim 4	
4.0	The method of claim 1, wherein an API of the third party application service provider system is incompatible with an API of the network provider system.

Dependent Claim 5	
5.0	The method of claim 4, wherein the API of the third party application service provider system is integrated with the unified services platform system,

5.1	and wherein API of the network provider system is integrated with the unified services platform system,
5.2	and wherein the third party application communicates with the network provider system through the unified services platform system.

Dependent Claim 6	
6.0	The method of claim 1, further comprising: receiving, by the unified services platform system, a second subscription request for a second service for the group plan, wherein the second service is provided by a second third party application service provider system,
6.1	wherein an API of the third party application service provider system is incompatible with an API of the second third party application service provider system;
6.2	sending, by the unified services platform system, a second activation request for the group plan to the third party application service provider system,
6.3	receiving a second activation response from the third party application service provider system;
6.4	associating the second service with each telephone number of the plurality of telephone numbers; and
6.5	providing access to the second service for each telephone number based on the associating.

Dependent Claim 7	
7.0	The method of claim 1, further comprising: invoking the service in response to a triggering event associated with a first telephone number of the plurality of telephone numbers.

I. INTRODUCTION

Zilkr Cloud Technologies, LLC, the owner of U.S. Patent No. 9,883,047 (“the ’047 Patent”), submits this Preliminary Response to the Petition of Cisco Systems, Inc. (“Cisco” or “Petitioner”) challenging the validity of Claims 1 and 4-7 of the ’047 Patent (“Challenged Claims”). The Board should deny the Petition for discretionary reasons and/or based upon the merits.

The Petition fails on the merits for multiple reasons. For example, for multiple reasons Raleigh fails to teach or suggest at least the claimed steps of “sending, by the unified services platform system, an activation request for the group plan to the third party application service provider system” [1.4], “receiving an activation response from the third party application service provider system” [1.5], “sending, by the unified services platform system, a second activation request for the service to the second third party application service provider system” [1.10], and “receiving a second activation response from the second third party application service provider system” [1.11].

For these and additional reasons described below, the Petition fails to show a reasonable likelihood of prevailing on at least one challenged claim.

The *Fintiv* factors also favor denying institution of Cisco’s Petition. Based on the median time-to-trial statistics, a Texas jury will consider invalidity of the ’047 Patent twelve months before the Board would be expected to render a final written

decision here, if trial were to be instituted. Trial in the district court would precede a potential final written decision by about eleven months under the district court's schedule setting trial. Moreover, the co-pending litigation presents overlapping issues, and the parties and the district court have already expended (and will continue to expend) significant time and resources by the time the Board is expected to issue a decision on institution, including the Court having issued its claim construction order. Proceeding here is thus a poor use of the Board's resources—especially given that Petitioner failed to provide an adequate *Sotera* stipulation.

II. RELATED PROCEEDINGS IN DISTRICT COURT

The '047 Patent is involved in *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, 2:22-cv-00166-JRG-RSP (E.D. Tex.) ("Texas Litigation"). The '047 Patent was also involved in *Zilkr Cloud Technologies, LLC v. RingCentral, Inc.*, 3:21-cv-02807-S (N.D. Tex.), which was terminated on April 12, 2022.

III. THE '047 PATENT

The '047 Patent, entitled "Multiple Service Group Interactions and Authorizations," was filed on April 8, 2016, and issued on January 30, 2018. Ex. 1001 at 1. The '047 Patent claims priority to continuation applications dating back to the filing of the application for Patent No. 9,210,254, filed November 22, 2013, and to provisional application No. 61/888,856, filed on October 9, 2013. *Id.*

The '047 patent provides technical solutions that can be used for digital services onboarding in telecommunications systems. The Zilkr technology increases revenue and customer retention for telecommunications providers by allowing their users to integrate multiple third-party services with the user's phone number all from a unified platform. *See, e.g., id.*, 7:37-40 (“The ability to integrate into the unified platform once and become available everywhere thus greatly increases the value to the service, the network provider, and/or the user.”).

The '047 Patent describes integrating two separate technological systems—a telephony network, such as a PSTN network, and a network of third-party applications connected via the internet. The patent describes a seamless integration of the two through a unified services platform, which is pictured below. *See id.*, Fig. 7.

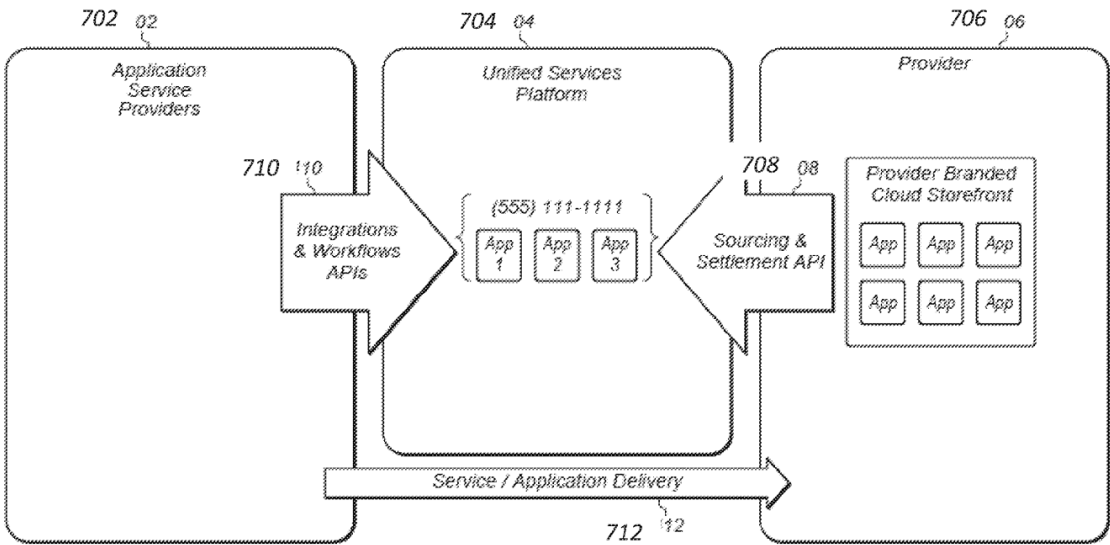
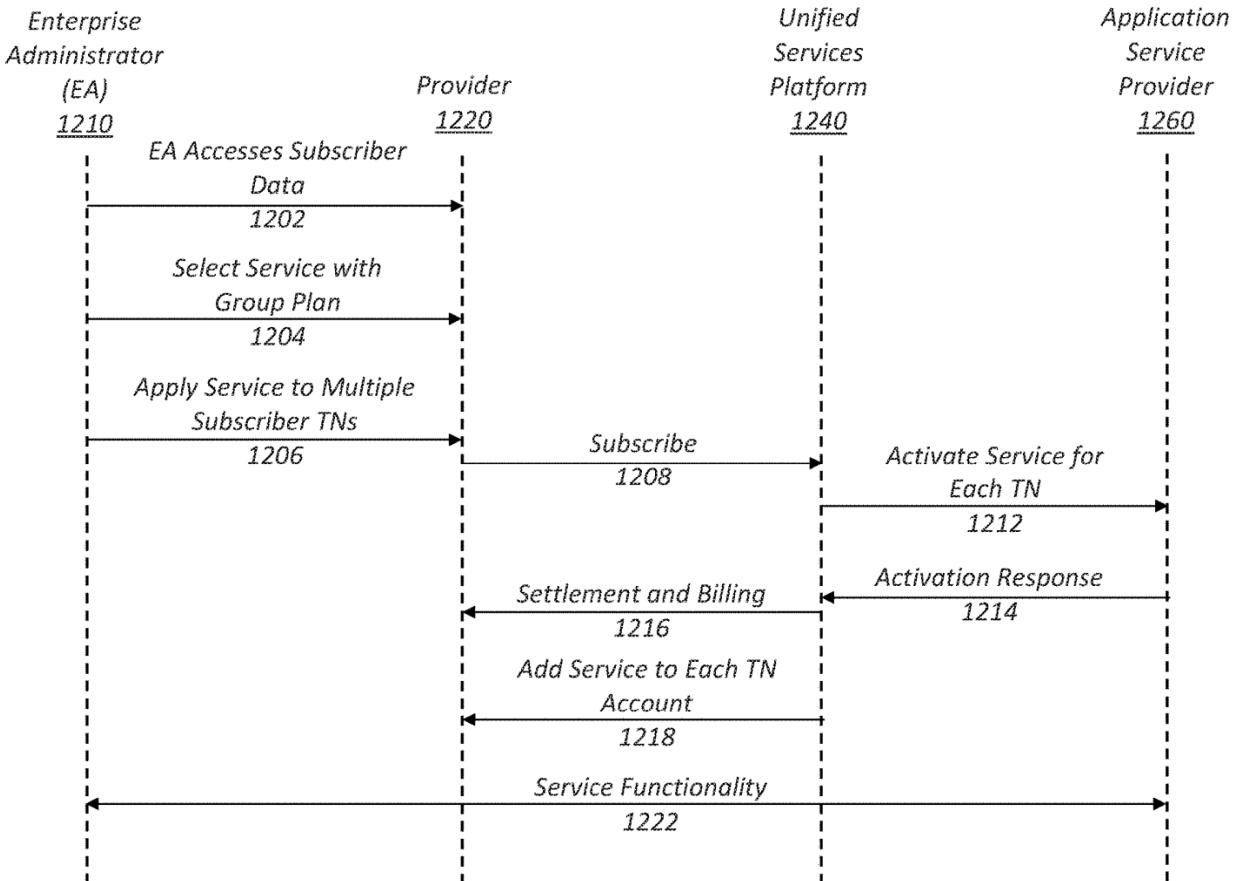


FIG. 7

FIG. 12 of the '047 Patent (below) illustrates an embodiment of an activation process in which an enterprise administrator is responsible for activating a service for one or more subscribers.

**FIG. 12**

The '047 Patent describes Figure 12 as follows:

For the purposes of this discussion, it will be assumed that the enterprise has selected a service to be added to the one or more subscriber accounts. The enterprise administrator 1210 may request the new service to be associated with the subscriber telephone numbers. In step 1202, the enterprise administrator 1210 may access the subscriber data for the subscribers to which the service is being added. The subscriber data may include an identification sent to the provider 1220, and the provider 1220 may or may not return additional account information to the enterprise administrator 1210. In an embodiment, the subscriber data may include the telephone numbers of the subscribers for which the service will be provided.

A request for the service or services is sent from the enterprise administrator 1210 to the provider 1220 in step 1204. The request sent to the provider 1220 may identify the specific services being requested. In addition, a group plan identifier can be included with the request to

identify the services as being associated with a group request. Each subscriber identifier such as the telephone number can be associated with the group plan identifier in step 1206. The provider 1220 may receive the request and in turn may generate and send a request in step 1208 to the unified services platform 1240 to source the desired services.

In response to receiving this request, the unified services platform 1240 may generate the appropriate activation data to activate the requested service and associate the service with the existing telephone numbers of the subscribers in the group plan. The unified services platform 1240 may generate configuration data in accordance with the API of the application service provider 1260 who is providing the requested service. Specifically, the unified services platform 1240 may generate activation data in step 1212 to the application service provider 1260. In an embodiment, the unified services platform 1240 may translate the telephone number into a second identifier (ID) that can be used to identify the subscriber and/or the group plan.

The unified services platform 1240 may also create a mapping of the group plan identification and/or the telephone numbers to the second ID and send this mapping to the provider 1220. The provider 1220 may store this mapping and use the mapping when initiating sessions of the service for the subscribers in the group plan. The activation response corresponding to the activation of the service may be returned from the application service provider 1260 in step 1214.

Ex. 1001, 30:43-31:22.

IV. OVERVIEW OF THE RELEVANT ALLEGED PRIOR ART

A. Raleigh (Ex. 1005)

Raleigh, entitled “Service Plan Design, User Interfaces, Application Programming Interfaces, and Device Management,” was filed on January 23, 2013, and published on May 23, 2013. Ex. 1005 at 1. Raleigh is directed to specific methods of enabling subscribers of mobile wireless communication devices to view, research, select, and customize service plans; to create and manage device groups,

share and set permission controls for service plans among devices in device groups; to manage communication services through graphical user interfaces; to sponsor and promote service plans; and to design, manage, and control communication services through application programming interfaces. *Id.*

In Raleigh, “FIGS. 35A and 35B illustrate representative processes to activate an association between a service provider and the mobile wireless communication device 105, e.g., to establish a new service account or associate the mobile wireless communication device with an existing service account of the service provider.” Ex. 1005, ¶ 1840. At least with respect to service provider selection, Raleigh’s “service provider” is the carrier. *See, e.g., id.* ¶ 428 (“In some embodiments a service provider (carrier) designs a suite of service plans”); Ex. 2001, ¶ 37. Raleigh describes that, “[i]n some embodiments, the mobile wireless communication device 105 is pre-programmed or configured to function with a particular service provider, so that selection of a service provider from a set of service providers is not required.” Ex. 1005, ¶ 1839. For example, some mobile phones are “locked” to only allow for activation with a particular service provider (carrier), such as Verizon. Ex. 2001, ¶ 37. “Figure 35A illustrates a first alternative process by which a service provider is activated for the mobile wireless communication device 105 based on information obtained from the mobile wireless communication device 105 and provided to a service provider system by the third party service partner system.” *Id.* ¶ 1840.

Raleigh’s description of the service provider selection process is consistent with activating a phone for use on a carrier’s network, and there is no indication that multiple service providers may be selected. *See id.*, ¶¶ 1839-1845; Ex. 2001, ¶ 38. As such, statements elsewhere in Raleigh relating to a service provider being a third party service partner may relate to selection of services, but are not consistent with the description of the selection of the service provider for the mobile device. *Id.*

Once the service provider is selected, services may then be selected as illustrated in Figures 36A-B. *See* Ex. 1005, ¶ 1846; Ex. 2001, ¶ 39. Raleigh’s statement that “[i]n some embodiments, selection of a service is conducted in conjunction with selection of a service provider as described above” (¶ 1846) means that a user can be prompted to select services immediately after selecting the service provider. This is evidenced by the next sentence, which presents an alternative in which selection of a service is prompted at a later time in response to certain conditions. Ex. 1005, ¶ 1846 (“In some embodiments, selection of a service is prompted by a notification trigger condition for the mobile wireless communication device 105, e.g., detection of no service plans, detection of an expiring or expired service plan, monitoring of particular service activities, monitoring of service usage, detection of a change in network state, etc.”); Ex. 2001, ¶ 39.

The Petition asserts that Raleigh describes a system configuration in Fig. 15I in which multiple devices “can sign-up with multiple different service providers

through a ‘sign-up request processor.’” Pet. 44-45. The Petition misinterprets Raleigh’s Figure 15I and description, which does not teach what the Petition asserts.

The “service operators” in Raleigh’s Figure 15I are network operators that sell mobile devices. Raleigh states that “a device manufacturer may want to have a common service sign-up and sharing management UI and process for all of its products and desires that the common service sign-up and sharing management UI and process are implemented consistently *across all of the service operators that are selling the manufacturer’s products.*” Ex. 1005, ¶ 926 (emphasis added). Thus, “the device manufacturer provides the Sign-Up Request Processor and the common API and work with the service operators to have them implement the required functionality to support the On-Device Service Sign-Up and Multi-Device sharing functions.” *Id.* Although multiple service operators can support these functions on a mobile device, only one is selected to do so. Ex. 2001, ¶ 41. The APIs simplify the process for signing up with a service operator, and allow, as an example, a device manufacturer such as Samsung to present a similar interface for signing up with a network provider no matter which provider is chosen. Ex. 2001, ¶ 42. This understanding of a single service operator for any mobile device is consistent with Raleigh’s statement that “[i]n some embodiments, the subscribers sharing a service plan must be subscribed to the same service operator.” Ex. 1005, ¶ 926. As with the service provider selection process described with reference to Figures 35A-B (*see*

Ex. 1005, ¶¶ 1840-1845), there is no indication that a mobile device may select multiple service operators/providers. Ex. 2001, ¶ 42.

V. STANDARDS

A. Institution of an IPR

Under 35 U.S.C. § 314(a), Petitioner carries the burden of showing a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375-77 (Fed. Cir. 2016).

B. Petitions Based on Obviousness

A petition based on obviousness must “meaningfully” address the first two *Graham* factors: (i) the scope and content of the prior art, and (ii) any differences between the claimed subject matter and the prior art. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). It is not the Board’s (or Patent Owner’s) role to “sift through the information” provided with a petition to identify the differences between a challenged claim and the prior art. *Google Inc. & Twitter, Inc., Petitioners, v. Everymd.com LLC., Pat. Owner.*, No. IPR2014-00347, 2014 WL 2175007, at *11 (P.T.A.B. May 22, 2014).

To assert obviousness by combining prior art references, Petitioner must prove that: (1) a motivation to combine the references exists; and (2) a POSITA

would have had a reasonable expectation of success in combining the references. *Apotex Inc. v. Wyeth LLC*, IPR2014-00115, Paper 94 at 11 (P.T.A.B. Apr. 20, 2015) (“A party that petitions the Board for a determination of obviousness must show that ‘a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had reasonable expectation of success in doing so.’”).

The requirement for proving reasonable expectation of success refers to achieving what is claimed in the patent-at-issue. *Intelligent Bio-Sys. V. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (“[O]ne must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the patent-at-issue.”). An articulated reason with a rational underpinning to combine specific teachings in the references in a particular manner to arrive at the claimed invention is required for a showing of obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

Objective indicia of non-obviousness cannot be ignored. *Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 59, at *9 (P.T.A.B. Apr. 2, 2018) (“Objective evidence of non-obviousness may often be the most probative and cogent evidence in the record and may often establish that an invention appearing to have been obvious in light of the prior art was not.”); *NuVasive, Inc. v. Iancu*, 752 F. App’x 985, 996 (Fed. Cir. 2018) (“On remand, the Board should reevaluate *NuVasive’s*

objective evidence of non-obviousness such as long-felt need . . .”). A necessary safeguard and, like here, a required aspect of a petition based exclusively on obviousness, is a forthright discussion of the objective indicia of non-obviousness. *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354-55 (Fed. Cir. 2013) (“Failure to give proper consideration to such evidence, as in this case, can be fatal . . .”).

Moreover, when an expert declaration is relied on to support obviousness, the “[l]ack of factual support for expert opinion going to factual determinations . . . may render the testimony of little probative value in a validity determination.” *Ashland Oil v. Delta Resins & Refractories*, 776 F.2d 281, 294 (Fed. Cir. 1985); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (PTAB Aug. 24, 2022) (precedential) (holding declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning).

C. Claim Construction

In an *inter partes* review filed on or after November 13, 2018, claim terms are construed based on their ordinary and customary meaning. 37 C.F.R. § 42.100(b). Patent Owner submits that the Board need not expressly construe any claim term in a particular manner to arrive at the conclusion that the Petition is substantively deficient.

Although Patent Owner provides arguments below on the scope of certain claim terms, Patent Owner does not propose a comprehensive construction, as it would not be necessary to resolve the controversy and deny the Petition. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)); *see also* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,353 (Oct. 11, 2018) (Final Rule) (“Moreover, it also may not be necessary to determine the exact outer boundary of claim scope because only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy (e.g., whether the claim reads on a prior art reference).” (citing *Nidec*)).

If trial is instituted, however, and to the extent deemed necessary to resolve any dispute, Patent Owner reserves the right to propose more specific constructions of one or more claim terms.

VI. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner defines a POSITA as having “a bachelor’s degree in electrical engineering, computer science, computer engineering, or an equivalent,” and “two years of experience in telecommunications and networking.” Pet. 12. Because the

Petition is deficient independent of the proposed level of ordinary skill, Patent Owner takes no position at this time with respect to Petitioner’s proposed level of ordinary skill in the art.

VII. PETITIONER’S PROPOSED OBVIOUSNESS CHALLENGE

Ground	'047 Patent Claims	Type	Reference(s)
1	1 and 4-7	§ 103	Raleigh

VIII. PETITIONER HAS FAILED TO SHOW THAT RALEIGH RENDERS OBVIOUS CLAIMS 1 AND 4-7

Petitioner argues Raleigh renders obvious the Challenged Claims of the '047 Patent. For at least the reasons discussed below, Petitioner has not established a reasonable likelihood of success that Raleigh renders obvious any of the Challenged Claims. The petition thus fails.

Patent Owner’s analysis is supported by the Declaration of Dr. Robert Akl. Ex. 2001 (“Akl Dec.”). Dr. Akl is well-qualified to offer the opinions provided in this art. *See* Ex. 2001, Akl. Dec., ¶¶ 1-19.

A. Claim 1

- 1. Raleigh does not teach “sending, by the unified services platform system, an activation request for the group plan to the third party application service provider system” [1.4] or “receiving an activation response from the third party application service provider system” [1.5]**

Petitioner argues Raleigh’s service provider selection process illustrated in Figures 35A-B shows the claimed “sending” and “receiving” steps of limitations

[1.4] and [1.5]. The Petition, however, confuses what Raleigh means by service provider selection. The selection of a service provider is used to set up a mobile device with a particular carrier, and does not activate a service. Raleigh’s “service provider” is also not a “third party application service provider” as required by the claim. *See* Ex. 2001 (Akl Dec.), ¶ 43.

In Raleigh, “FIGS. 35A and 35B illustrate representative processes to activate an association between a service provider and the mobile wireless communication device 105, e.g., to establish a new service account or associate the mobile wireless communication device with an existing service account of the service provider.” Ex. 1005, ¶ 1840. At least with respect to service provider selection, Raleigh’s “service provider” is the carrier. *See, e.g., id.* ¶ 428 (“In some embodiments a service provider (carrier) designs a suite of service plans”); Ex. 2001, ¶ 44. Raleigh describes that, “[i]n some embodiments, the mobile wireless communication device 105 is pre-programmed or configured to function with a particular service provider, so that selection of a service provider from a set of service providers is not required.” Ex. 1005, ¶ 1839. For example, some mobile phones are “locked” to only allow for activation with a particular service provider (carrier), such as Verizon. Ex. 2001, ¶ 45. “Figure 35A illustrates a first alternative process by which a service provider is activated for the mobile wireless communication device 105 based on information obtained from the mobile wireless communication device 105 and provided to a

service provider system by the third party service partner system.” Ex. 1005, ¶ 1840. Raleigh’s description of the service provider selection process is consistent with activating a phone for use on a carrier’s network, and there is no indication that multiple service providers may be selected. *See id.*, ¶¶ 1839-1845; Ex. 2001, ¶ 46. As such, statements elsewhere in Raleigh relating to a service provider being a third party service partner may relate to selection of services, but are not consistent with the description of the selection of the service provider for the mobile device. Ex. 2001, ¶ 46.

Once the service provider is selected, services may then be selected as illustrated in Figures 36A-B. *See* Ex. 1005, ¶ 1846; Ex. 2001, ¶ 47. Raleigh’s statement that “[i]n some embodiments, selection of a service is conducted in conjunction with selection of a service provider as described above” (¶ 1846) means that a user can be prompted to select services immediately after selecting the service provider. This is evidenced by the next sentence, which presents an alternative in which selection of a service is prompted at a later time in response to certain conditions. Ex. 1005, ¶ 1846 (“In some embodiments, selection of a service is prompted by a notification trigger condition for the mobile wireless communication device 105, e.g., detection of no service plans, detection of an expiring or expired service plan, monitoring of particular service activities, monitoring of service usage, detection of a change in network state, etc.”); Ex. 2001, ¶ 47.

The Petition appears to use Raleigh’s statement that selection of a service can be done “in conjunction with selection of a service provider” as an excuse to conflate the two processes. *See* Pet. 22, 33-35. At most, selection of a particular service provider (carrier) for a phone may affect which service plans are available, but Raleigh does not teach any other connection between selection of the service provider and selection of services. Ex. 2001, ¶ 48. In contrast, reading claim 1 as a whole, the activation request for the group plan sent by the unified services platform system to the third party application service provider system relates to the subscription request for a service for a group plan, as recited in limitation [1.1]. Ex. 2001, ¶ 49. In other words, the “activation request” and “activation response” in limitations [1.4] and [1.5] are for activating the service for a group plan that is the subject of the subscription request in limitation [1.1]. Ex. 2001, ¶ 49; *see also* claim limitation [1.10] reciting “sending, by the unified services platform system, *a second activation request for the service* to the second third party application service provider system.” The Petition does not show that Raleigh teaches such an activation request and response, and instead relies on the prerequisite process of selecting a service provider. *See* Pet. 33-36. Thus, the Petition fails to show that Raleigh teaches the limitations of claim elements [1.4] and [1.5]. *See* Ex. 2001, ¶ 50.

In addition, the Petition is incorrect that Raleigh’s “service provider” system can be considered the claimed “third party application service provider system.” In

the '047 Patent, a “third party application service provider” is distinct from the network provider, which provides the phone numbers for the group plan. *See* Ex. 1001, 3:15-18 (“The telephone number is provided by a network provider system, and a plurality of service provided by a plurality of third party service systems are associated with the telephone number.”); Ex. 2001, ¶ 51. As discussed above, the “service provider” selected for the mobile device in Raleigh’s Figures 35A-B is the carrier, and this is the entity that receives Raleigh’s activation request. Accordingly, there is no activation request sent “to the third party application service provider system” or activation response received “from the third party application service provider system,” as required by claim 1 of the '047 Patent. *See* Ex. 2001, ¶ 52. For these additional reasons, Petitioner has not shown that Raleigh teaches the limitations of claim elements [1.4] and [1.5].

2. Raleigh does not teach “sending, by the unified services platform system, a second activation request for the service to the second third party application service provider system” [1.10] or “receiving a second activation response from the second third party application service provider system” [1.11]

Claim 1 of the '047 Patent recites steps in limitations [1.8]-[1.13] that are similar but not identical to the steps in limitations [1.1]-[1.7]. For limitations [1.10] and [1.11], the Petition refers to its arguments for limitations [1.4] and [1.5]. *See* Pet. 48. The Petition fails to show that Raleigh teaches limitations [1.10] and [1.11] for at least the same reasons given above for limitations [1.4] and [1.5]. In addition,

claim element [1.10] explicitly recites sending “a second activation request *for the service*,” emphasizing that the activation request refers back to the service and is not met by an activation related to selecting a service provider as alleged in the Petition. Ex. 2001, ¶ 53.

As an additional and independent reason that the Petition fails, Raleigh *does not* teach repetition of the selection of the service provider for a mobile device. Because Petitioner’s mapping for limitations [1.10] and [1.11] relies on the argument that Raleigh selects multiple service providers, the Petition fails for this additional reason.

As discussed above in connection with limitations [1.4] and [1.5], Raleigh’s description of the service provider selection process is consistent with activating a phone for use on a carrier’s network, and there is no indication that multiple service providers may be selected. See Ex. 1005, ¶¶ 1839-1845; Ex. 2001, ¶ 54. The Petition asserts that Raleigh describes a system configuration in Fig. 15I in which multiple devices “can sign-up with multiple different service providers through a ‘sign-up request processor.’” Pet. 44-45. The Petition misinterprets Raleigh’s Figure 15I and description, which does not teach what the Petition asserts.

The “service operators” in Raleigh’s Figure 15I are network operators that sell mobile devices. Raleigh states that “a device manufacturer may want to have a common service sign-up and sharing management UI and process for all of its

products and desires that the common service sign-up and sharing management UI and process are implemented consistently *across all of the service operators that are selling the manufacturer's products.*" Ex. 1005, ¶ 926 (emphasis added). Thus, "the device manufacturer provides the Sign-Up Request Processor and the common API and work with the service operators to have them implement the required functionality to support the On-Device Service Sign-Up and Multi-Device sharing functions." *Id.* Although multiple service operators can support these functions on a mobile device, only one is selected to do so. Ex. 2001, ¶¶ 55-56. The APIs simplify the process for signing up with a service operator, and allow, as an example, a device manufacturer such as Samsung to present a similar interface for signing up with a network provider no matter which provider is chosen. *Id.*, ¶ 57. This understanding of a single service operator for any mobile device is consistent with Raleigh's statement that "[i]n some embodiments, the subscribers sharing a service plan must be subscribed to the same service operator." Ex. 1005, ¶ 926; Ex. 2001, ¶ 57. As with the service provider selection process described with reference to Figures 35A-B (*see* Ex. 1005, ¶¶ 1840-1845), there is no indication that a mobile device may select multiple service operators/providers. Ex. 2001, ¶ 57.

Because the Petition's mapping of claim elements [1.10] and [1.11] relies on the mistaken understanding of Raleigh that a device could select multiple service providers (and therefore repeat the activation and request steps), it fails to show that

Raleigh teaches the limitations of claim elements [1.10] and [1.11] for this additional reason. *See* Ex. 2001, ¶ 58.

B. Petitioner Has Not Shown That Raleigh Renders Obvious Dependent Claims 4-7

For at least the reasons discussed in Section VIII.A (incorporated by reference herein), Petitioner has not shown that Raleigh teaches or renders obvious claims 4-7, which depend from claim 1.

IX. THE BOARD SHOULD DENY INSTITUTION OF THIS PETITION UNDER 35 U.S.C. § 314(A)

Under § 314(a), the Director has discretion to deny institution. *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). *Fintiv* sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

These factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of

discretion, including the merits grounds raised in the Petition.

Id.

According to the Memorandum from Director Vidal dated June 21, 2022, “compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Ex. 1016 at 4. Moreover, “[w]hen a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *Id.* at 7 (citation omitted).

Here, the *Fintiv* factors favor denial of institution of this Petition, and Petitioner has not presented compelling evidence of unpatentability. Nor has Petitioner provided a sufficient stipulation that it will not pursue in the Texas litigation “any grounds that could have reasonably been raised in the petition.” *Id.* (emphasis added).

As such, the Board should deny institution of this Petition under § 314(a).

A. Factor 1 is Neutral as No Court Has Granted a Stay and No Evidence Exists That a Stay May Be Granted

Regarding Factor 1, the parallel district court proceeding has not been stayed and no evidence exists that a stay may be granted if trial is instituted. The parallel district court proceeding includes three other U.S. patents besides the '047 Patent. Petitioner has never moved for a stay. The issues raised in the Petition are already presented, and are already being litigated, in the United States District Court for the Eastern District of Texas in *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, 2:22-cv-00166-JRG-RSP (“Texas litigation”). Factor 1 is thus neutral at best. *See, e.g., Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00123, 2020 WL 2511247, at *3 (P.T.A.B. May 15, 2020) (finding factor 1 to be neutral where “there is little evidence to suggest that the district court will grant a stay, should another one be requested”).

B. Factors 2 and 5 Weigh in Favor of Denying Institution

As to factors 2 and 5, Petitioner is the defendant in the Texas litigation (Pet. 70), the *Markman* hearing took place on July 14, 2023, the claim construction order was issued on August 4, 2023 (*see* Ex. 2002), and jury selection is scheduled to begin January 22, 2024 (Ex. 2003).¹ The final written decision in this case would be

¹ On August 30, 2023, the Court issued a Second Amended Docket Control Order

expected around December 14, 2024, if trial were instituted. Thus, the district court's trial is scheduled to precede the Board's potential final written decision by almost eleven months.

This timing difference is greater than that in *NHK* where the Board noted a six-month difference between a scheduled trial date and the deadline for the Board's written decision. *NHK*, IPR2018-00752, Paper 8 at 20; *see also GlobalFoundries Inc. v. UNM Rainforest Innovations*, IPR2020-00984, Paper 11, at *11-16 (PTAB Dec. 9, 2020) (finding that a scheduled trial date four months before the statutory deadline for a final written decision was a factor weighing in favor of discretionary denial); *NanoCollect Biomedical, Inc. v. Cytonome/ST, LLC*, IPR2020-00551, Paper 19, at *16 (PTAB Aug. 27, 2020) (same); *Intel Corp. v. LLC*, No. IPR2020-00583, 2021 WL 531706, at *2 (P.T.A.B. Feb. 11, 2021) ("Thus, at this time, it appears likely that trial will occur many months before any final written decision would likely issue in this proceeding. Therefore, we maintain our finding that *Fintiv* Factor 2 (proximity of the court's trial date to the Board's projected statutory deadline for a final written decision) weighs in favor of exercising our discretion to deny institution pursuant to 35 U.S.C. § 314(a).").

modifying certain dates, but keeping the January 22, 2024 date for jury selection at the beginning of trial.

Just like in *NHK*, instituting trial under the facts and circumstances here would be an inefficient use of Board resources. *See NHK*, IPR2018-00752, Paper 8 at 20 (finding under similar circumstances that institution “would not be consistent with ‘an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation’”).

Petitioner’s contention that Factor 2 is neutral based on the median time-to-trial statistics for the Eastern District of Texas lacks merit. Pet. 68-69. The Memorandum from Director Vidal dated June 21, 2022, instructs only that “the proximity to trial should not alone outweigh” other factors. Ex. 1016 at 8. As shown herein, other factors besides Factor 2 weigh in favor of denial, such as Factors 3, 4, 5, and 6, and no factors favor declining to exercise the Board’s discretion to deny institution. Moreover, based on the median time-to-trial in the Eastern District of Texas (19 months), trial would take place around December 2023 (May 20, 2022 + 19 months). This suggests that the scheduled trial date of January 22, 2024 is likely to hold. Under the median time to trial statistics, trial would occur about twelve months prior to the expected December 2024 final written decision (if trial were to be instituted).

Factors 2 and 5 thus weigh in favor of denying institution.

C. Factor 3 Weighs in Favor of Denying Institution, as the Parties and the District Court in the Eastern District of Texas Litigation Have Already Invested Significant Time and Resources

By the time the Board’s institution decision is likely to issue in December 2023, the Parties and the district court will have already expended considerable time and resources, and will be on the eve of trial. For example, the district court has already conducted the July 14, 2023, claim construction hearing and issued its claim construction order. *See Google LLC v. Personalized Media Commc’ns, LLC*, No. IPR2020-00720, 2020 WL 6530766, at *2 (P.T.A.B. Nov. 5, 2020) (recognizing that “*Fintiv* holds that a district court’s investment in issuing a claim construction order weighs toward, not against, exercising discretion to deny institution”). Fact discovery closed on September 13, 2023. Ex. 2003 at 3. Expert discovery is expected to be completed on October 19, 2023, and the deadline to file dispositive motions follows shortly thereafter on October 24, 2023. *Id.*

Based on the significant time and resources the parties have already expended and will have expended by the time of the expected decision on institution, Factor 3 weighs in favor of denying institution.

D. Factor 4 Weighs in Favor of Denying Institution Given the Overlap in Arguments Presented in the Petition and in the Texas Litigation and Because Petitioner has not Adequately Mitigated

Concerns of Potentially Conflicting Decisions and Duplication of Efforts

As to factor 4, Petitioner’s invalidity contentions in the Texas litigation state that it reserves the right to present additional references beyond those listed, and the Petition here states only that there will be no overlap of issues because Petitioner purports to stipulate that “if the Board institutes trial, Petitioner will cease asserting in the co-pending litigation the reference on which trial is instituted for the claims, to the extent Petitioner even asserts the same combination in the district court.” Pet. 69-70. Petitioner’s “stipulation” is insufficient to alleviate any concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB because Petitioner fails to stipulate that it will not pursue “any grounds that could have reasonably been raised in the petition.”² Ex. 1016 at 7 (emphasis added); *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020- 01019, Paper 12 at 19 (stating that a “Sotera” stipulation “ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding”); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01551 (P.T.A.B. May 5, 2023), Paper 10 at 17-18 (exercising discretion to deny institution based on, *inter alia*, “the late state of the parallel district court proceeding” and petitioner’s failure to submit a *Sotera*-type stipulation “that would make discretionary denial inappropriate”).

² Even if it did, Factors 2, 3, 5, and 6 would still favor denial.

Factor 4 thus weighs in favor of denying institution.

E. Factor 6 Weighs Against Institution as Petitioner Has Not Shown a Reasonable Likelihood That It Would Prevail on Ground 1 and/or Ground 2

Factor 6 considers other circumstances that impact the Board’s exercise of discretion. According to Petitioner, Factor 6 weighs against denial “[i]n view of the striking similarities between the ’047 patent claims and the Raleigh primary prior art reference.” Pet. 70. But, as shown above, Petitioner has failed to show a reasonable likelihood that it would prevail on its challenge.

Thus, to the extent Factor 6 takes into account the merits of Petitioner’s claims, Factor 6 weighs in favor of denial.

X. CONCLUSION

For the reasons stated above, Patent Owner respectfully asks the Board to deny institution of IPR2023-00822.

Dated: September 14, 2023

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(b)(1)

I, the undersigned, do hereby certify that the foregoing Patent Owner Preliminary Response, including footnotes, contains no more than 14,000 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24(b)(1).

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CERTIFICATE OF SERVICE

I hereby certify that on this 14th day of September, 2023, a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE, and any accompanying exhibits, was served by electronic mail upon the following counsel of record for Petitioners:

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